

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: SIDNEY HORNBY Attorney Docket No.: NEU 5012USNP
Serial No.: 10/674,715 Art Unit/Confirmation No: 1615/4536
Filed: September 30, 2003 Examiner: J. VENKAT
For: HAIR CONDITIONING PRODUCTS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPEAL BRIEF

Real Party in Interest

The real party in interest is Johnson & Johnson Consumer Companies, Inc., the assignee of the application.

Status of the Claims

Claims 1, 2, 4-7 and 11-14 are pending herein and have been finally rejected in the Office Action mailed February 7, 2008. These claims are on appeal.

Claims 3, 8, and 9 have been withdrawn due to restriction requirement.

Claims 15-21 have been cancelled.

Claim 10 has not been allowed, rejected or withdrawn. Applicants respectfully request clarification of the status of claim 10.

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that, on the date shown below, this correspondence is being transmitted to the USPTO via the electronic filing system in accordance with 37 CFR 1.6(a)(4)

Date: January 6, 2009

/ Sylvia G. Brown /

Signature

Sylvia G. Brown

(type or print name of person certifying)

Status of Amendments

No amendments to the claims have been filed subsequent to the final rejection.

Summary of the Claimed Subject Matter

Claim 1 is the sole independent claim on appeal. It recites a product comprising a composition for conditioning the hair, said composition comprising: (i) a first hair conditioning agent, wherein said first hair conditioning agent penetrates into the core of the hair; (ii) a second hair conditioning agent, wherein said second hair conditioning agent penetrates into the cortex region of the hair but does not substantially penetrate into the core of the hair; and (iii) a third hair conditioning agent, wherein said third hair conditioning agent remains on the hair surface and does not substantially penetrate into the cortex of the hair; wherein said product comprises advertising stating that said first hair conditioning agent, said second hair conditioning agent, and said third hair conditioning agent condition different regions of the hair. See Specification, page 1, line 33, to page 2, line 8, and original claim 1.

Grounds for Rejection to be Reviewed on Appeal¹

Whether claims 1, 2, 4-7 and 11-14 are obvious under 35 U.S.C. 103(a) over the combination of US Patent No. 4,999,187 ('187) and US Patent No. 5,843,193 ('193).

Argument

With respect to Claims 1, 2 4-7 and 11-14, the Examiner argues the '187 patent discloses a hair treatment composition containing olive oil and almond oil, and that oils are known conditioning agents since they provide emolliency to the hair/scalp. The Examiner acknowledges that the '187 patent does not teach or suggest the use of meadowfoam seed

¹ Claim 1 has been provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 1-2 and 4-8 of co-pending Application No. 10/675,868. Applicants have agreed to file an appropriate terminal disclaimer upon the indication of allowable subject matter.

oil, but argues this is taught by the '193 patent, which discloses a hair dye that may optionally contain a fatty oil such as meadowfoam seed oil. The Examiner argues it would have been obvious to add meadowfoam seed oil to the oils used by the '187 patent. The Examiner further argues that the advertising contained in the product does not carry any patentable weight.

Applicants disagree. First, the two references and the claimed invention relate to three different product classes. The claimed invention is a hair conditioner. The '187 patent relates to a hair treatment composition for treating dandruff and growing hair, although it may condition. The '193 patent relates to a hair dye. Nothing is said in the '193 patent about conditioning.

Accordingly, oils, to the extent they are contained in the compositions of the references, are not necessarily performing the same functions. The Examiner argues, without any evidence, that the oils of the references are there to condition. There is no proof of this, however, and given that the compositions of the references are treating different conditions, it would seem to be inappropriate to conclude this from the references.

This is especially true given that the claimed composition further requires each of the three oils to have a particular function: one that penetrates into the core of the hair, one that penetrates into the cortex of the hair but does not substantially penetrate into the core of the hair, and one that does not substantially penetrate into the cortex of the hair. This is explicit in the claims. It is the result of applicants' recognition that different hair conditioning agents chemically affect the hair differently, and that by combining three hair conditioning agents with three different functions, a new and superior hair conditioning composition results. Applicants do not dispute that various oils such as those used herein are known in the art. However, identification of their chemical behavior and deliberate combination of them based on such chemical behavior is not found in the prior art.

The Examiner argues that such properties would be inherent in the oils chosen, but then cites applicants' data in Example 8 in support of this. Such use of applicants' own data amounts to improper hindsight reasoning. The claimed discovery is simply not found in the references.

Applicants therefore submit that the rejection under Section 103(a) should be withdrawn.

Conclusion

For these reasons, reversal of the rejections of record is respectfully requested.

Respectfully submitted,

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CLAIMS APPENDIX

1. (previously presented) A product comprising a composition for conditioning the hair the hair, said composition comprising: (i) a first hair conditioning agent, wherein said first hair conditioning agent penetrates into the core of the hair; (ii) a second hair conditioning agent, wherein said second hair conditioning agent penetrates into the cortex region of the hair but does not substantially penetrate into the core of the hair; and (iii) a third hair conditioning agent, wherein said third hair conditioning agent remain on the hair surface and does not substantially penetrate into the cortex of the hair; wherein said product comprises advertising stating that said first hair conditioning agent, said second hair conditioning agent, and said third hair conditioning agent condition different regions of the hair.
2. (original) A product of claim 1, wherein said first hair conditioning agent, said second hair conditioning agent, and said third hair conditioning agent are oils.
3. (withdrawn) A product of claim 1, wherein said first hair conditioning agent is selected from the group consisting of avocado oil, apricot kernel oil, olive oil, sesame oil, coconut oil, and PEG-7 oivate.
4. (original) A product of claim 1, wherein said first hair conditioning agent is olive oil.
5. (original) A product of claim 1, wherein said second hair conditioning agent is meadowfoam seed oil.
6. (original) A product of claim 3, wherein said second hair conditioning agent is meadowfoam seed oil.
7. (original) A product of claim 4, wherein said second hair conditioning agent is meadowfoam seed oil

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8. (withdrawn) A product of claim 1, wherein said third hair conditioning agent is selected from the group consisting of PEG-8/SMDI copolymer, palmitoyl myristyl serinate, jojoba oil, almond oil, mineral oil and sunflower oil.

9. (withdrawn) A product of claim 3, wherein said third hair conditioning agent is selected from the group consisting of PEG-8/SMDI copolymer, palmitoyl myristyl serinate, jojoba oil, almond oil, mineral oil and sunflower oil.

10. (original) A product of claim 6, wherein said third hair conditioning agent is selected from the group consisting of PEG-8/SMDI copolymer, palmitoyl myristyl serinate, jojoba oil, almond oil, and sunflower oil.

11. (original) A product of claim 1, wherein said third hair conditioning agent is almond oil.

12. (original) A product of claim 3, wherein said third hair conditioning agent is almond oil.

13. (original) A product of claim 6, wherein said third hair conditioning agent is almond oil.

14. (original) A product of claim 1, wherein said product further comprises instructions instructing the user to rinse the composition from the hair following application.

15-21. (canceled)

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.